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| 10/051,316 | 01/18/2002 | Alfred Thomas | 07-2169 | 8018 |
| 20306 7590 10/16/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606 | | | EXAMINER OMOTOSHO, EMMANUEL | |
| | | | ART UNIT 3714 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/051,316

Applicant(s)

THOMAS ET AL.

Examiner

Emmanuel Omotosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 112-114, 128 and 129 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 112-114, 128-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination (RCE)

This is in response to the RCE filed 07/24/07 wherein claims 112-114 and 128-129 are pending.

Allowable Subject Matter

The indicated allowability of claims 112-114 and 128-129 are withdrawn in view of the newly discovered reference(s) to Byrne US Pub No. 2005/0014553 A1 and Marnell, II US Patent 5.393.057. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

1. Claim 129 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 129 claims an award that is non-monetary. However, all awards from a game has some value associated with it (i.e. actual currency value, tokens to redeem currency value, tickets to redeem prizes that has value etc.) therefore all awards in a sense has some monetary value associated with it.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 112-114, 128-129 are rejected under 35 U.S.C. 102(e) as being anticipated by Byrne US Pub No. 2005/0014553 A1.
3. Claims 112-113: Byrne teaches a method of operating a gaming machine, comprising the steps of:
 - a. Placing a wager (first paragraph claim 37),
 - b. Providing a first game of chance wherein said first game of chance is a card game employing a deck of cards and includes dealing a hand of cards to a player from said deck of cards (first paragraph of claim 37 & 39).
 - c. Providing a second game of chance operated at the beginning of said first game of chance and in conjunction with said first game of chance, wherein said second game of chance is a game having a plurality of differing award indicia, wherein said award indicia are assigned to each card dealt from said deck of cards (paragraphs 2-3 and 5 of claim 37, Par 0042 and 0044 and claim 39).
 - d. Wherein said second game of chance displays award indicia associated in a one to one correspondence with a card in said first game of chance hand, each award indicia being selected as well as discarded in accordance with its associated card (Par 0042 and 0044 and claim 39),

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said card game including the further step of replacing any discarded card with another randomly selected card and said second game of chance including the step of replacing any discarded award indicia with another randomly selected award indicia (Par 206, this is inherent since in poker one can discard a card and replace a card with a random card).

e. Wherein said second game of chance has the potential on every play thereof for achieving an award; and awarding any award achieved in said second game of chance (last paragraph of claim 37).

4. Claims 114-115,128: Byrne teaches a method of operating a gaming machine, comprising the steps of

f. Placing a wager (first paragraph claim 37),

g. Providing a first game of chance on a first position of said gaming machine wherein said first game of chance is a slot game having a reel display with a particular number of reels having first game indicia thereon, and wherein said step of providing said first game of chance includes a display of randomly selected first game indicia for each real (first paragraph of claim 37 & claim 40).

h. Providing a second game of chance on a second position of said gaming machine separate and distinct from said first position, said second game of chance is operated only in conjunction with said first game of chance irrespective of said display of randomly selected first game indicia for each real, wherein said second game of chance includes having a plurality of award indicia different from said first game indicia, a preset

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number of said award indicia being displayed in the course of said second game through a random selection, wherein said preset number of said award indicia is the same as said particular number of reels in said first game of chance, wherein said award indicia are associated in a one to one correspondence with said reels in said first game of chance, and awarding any award (i.e. a tangible good) achieved in said second game of chance (paragraphs 3-5 of claim 37 & claim 40. Par 0042 and Par 0044).

- i. The indicia are representative of a tangible (non-monetary) award (i.e. prize, Claim 37).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 112-114, 128-129 are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell, II US Patent 5.393.057.
7. Claims 112-113: Marnell teaches a method of operating a gaming machine, comprising the steps of:
 - j. Placing a wager, providing a first game of chance wherein said first game of chance is a card game employing a deck of cards and includes

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dealing a hand of cards to a player from said deck of cards (abstract, fig 1 and 2).

k. Providing a second game of chance operated at the beginning of said first game of chance and in conjunction with said first game of chance, wherein said second game of chance is a game having a plurality of differing award indicia, wherein said award indicia are assigned to each card dealt from said deck of cards (abstract, fig 1 and 2, par 4:23-30, par 5:50-60).

l. Wherein said second game of chance displays award indicia associated in a one to one correspondence with a card in said first game of chance hand, each award indicia being selected as well as discarded in accordance with its associated card (, par 4:23-30, par 5:50-60), said card game including the further step of replacing any discarded card with another randomly selected card and said second game of chance including the step of replacing any discarded award indicia with another randomly selected award indicia (par 4:30-39).

m. Wherein said second game of chance has the potential on every play thereof for achieving an award; and awarding any award achieved in said second game of chance (par 6:18-27).

8. Claims 114-115,128: Marnell teaches a method of operating a gaming machine, comprising the steps of

n. Placing a wager (abstract, fig 1 and 2), providing a first game of chance on a first position of said gaming machine wherein said first game

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of chance is a slot game having a reel display with a particular number of reels having first game indicia thereon, and wherein said step of providing said first game of chance includes a display of randomly selected first game indicia for each reel (abstract, fig 1 and 2, par 4:23-30,par 5:50-60).

o. Providing a second game of chance on a second position of said gaming machine separate and distinct from said first position, said second game of chance is operated only in conjunction with said first game of chance irrespective of said display of randomly selected first game indicia for each reel, wherein said second game of chance includes having a plurality of award indicia different from said first game indicia, a preset number of said award indicia being displayed in the course of said second game through a random selection, wherein said preset number of said award indicia is the same as said particular number of reels in said first game of chance, wherein said award indicia are associated in a one to one correspondence with said reels in said first game of chance, and awarding any award (i.e. a tangible good) achieved in said second game of chance abstract, fig 1 and 2, par 4:23-30,par 5:50-60).

9. The indicia are representative of a tangible (non-monetary) award (i.e. benefit, par 5:50-60).

Conclusion

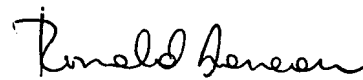
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Omotosho whose telephone number is (571) 272-3106. The examiner can normally be reached on m-f 10-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO



RONALD LANEAU
PRIMARY EXAMINER

10/11/07